

S/N: 10/780,487

Atty Dkt No. GP-303547 / GM0424NS

### REMARKS

Claims 1-15 are pending. Claims 1-5 are finally rejected under 35 U.S.C. § 102(b) as being anticipated by Hertzell (3,718,357). Claims 6-10, 14, and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by Farkash (6,406,045). Claims 11 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Farkash in view of Whitfield (5,333,923). Claim 13 is allowed. Applicants request reconsideration of the rejections in view of this reply.

#### 1. Rejection of claims 1-5 as being anticipated by Hertzell

Claim 1 recites, *inter alia*, a step assembly for a vehicle comprising “a base member ... having a base member stepping surface; and at least one movable member being selectively repositionable ... such that the length of the step assembly is selectively variable.” (emphasis added).

In rejecting claim 1, the Examiner states that “Hertzell teaches a step assembly ... comprising of a base member ... [and] one movable member being selectively repositionable ... such that the length of the step assembly is selectively variable.”

Applicants noted in the Amendment filed September 14, 2005 that “Hertzell does not disclose that the length of bumper guard assembly 60 is selectively variable.” Applicants then explained that Webster’s New Universal Unabridged Dictionary provides the following relevant definitions for “length”: “the longest extent of anything as measured from end to end”; and “the measure of the greatest dimension of a plane or solid figure.” (emphasis added).

Applicants further explained that, although one dimension, i.e. the transverse dimension, of Hertzell’s bumper guard assembly may be selectively variable, the transverse dimension is not the “greatest dimension” of the bumper guard assembly, nor is the transverse dimension of Hertzell’s bumper guard assembly “the longest extent” of the bumper guard assembly. Since the length, i.e., the “greatest dimension” or the

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"longest extent," of Hertzell's bumper guard assembly is not selectively variable, as recited by claim 1, claim 1 is clearly not anticipated by Hertzell.

In the Office Action mailed November 22, 2005, the Examiner responds by stating that "Examiner takes the length of the bumper guard assembly 60 [of Hertzell] to be selectively variable in the transverse direction, which is shown in Figure 2." (Page 5, lines 12-13) (emphasis added). However, as Applicants noted *supra* and in the amendment filed September 14, 2005, the length of an object is the "greatest dimension" or the "longest extent" of the object. The "transverse direction" of Hertzell's bumper guard assembly 60 is not the "greatest dimension" of the bumper guard assembly, nor is the transverse direction the "longest extent" of Hertzell's bumper guard assembly 60. Thus, although Hertzell's bumper guard assembly may be selectively variable in the transverse direction, the transverse direction is not the length of the bumper guard assembly. Hertzell does not teach that the length of the bumper guard assembly is selectively variable.

The Examiner further responds by stating, at page 5, lines 7-9 of the 11/22/05 Office action, that "it is noted that the features upon which applicant relies (i.e., the length of the step assembly is selectively variable) in the longitudinal direction are not specifically recited in the rejected claim(s)." (emphasis added). However, by definition, the length is the longitudinal direction. Applicant refers the Examiner to the definition of "longitudinal": "placed or running lengthwise"; or "of or relating to length or the lengthwise direction." (Webster's Ninth New Collegiate Dictionary 1991) (emphasis added). If the length of the step assembly of claim 1 is selectively variable, it is selectively variable in the lengthwise direction, i.e., in the longitudinal direction. Accordingly, the limitations on which Applicant relies are indeed recited in the claim: if the length of the step assembly is selectively variable, then by definition it is variable in the longitudinal direction.

Claims 1-5 ultimately depend from claim 1 and are therefore allowable for at least the same reasons that claim 1 is allowable.

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2. Rejection of claims 6-10, 14 and 15 as being anticipated by Farkash

Claim 6 recites, *inter alia*, "at least one movable member ... being selectively repositionable fore and aft with respect to the vehicle body." In the first Office Action, the Examiner merely states that "Farkash ... teaches ... one movable [sic] defining a movable member stepping surface (see fig 6, element 52) and being selectively repositionable with respect to the vehicle body such that the length of the step assembly is selectively variable."

In the Amendment of September 14, 2005, Applicants noted that "the Examiner does not address the limitation recited by claim 6 that the movable member defining a stepping surface is selectively repositionable fore and aft. It is apparent from Figures 1 and 5-6 of Farkash that, although drawer 52 may move transversely with respect to the vehicle body 12, drawer 52 of Farkash is not movable fore and aft."

In the "Response to Arguments" section of the Office Action mailed November 22, 2005, the Examiner responds by clarifying that the movable member of Farkash that defines a stepping surface is element 56, not element 52, and then stating "However, the claimed movable member stepping surface is selectively repositionable with respect to the vehicle body such that the length of the step assembly is selectively variable by viewing figure 6 as well as viewing column 6, lines 11-19.

Again, the Examiner fails to address or acknowledge the limitation recited by claim 6 that the "movable member ... is selectively repositionable fore and aft with respect to the vehicle body." As shown in Figure 6 of Farkash, element 56 may be pivotable up and down, but clearly does not move "fore and aft" with respect to the vehicle body. Accordingly claim 6 recites at least one limitation that is not taught expressly or inherently by Farkash, and, therefore, the rejection of claim 6 under 35 U.S.C. § 102(b) is improper.

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Claims 7-10 and 14-15 ultimately depend from claim 6 and are therefore allowable for at least the same reasons that claim 6 is allowable.

3. Rejection of claims 11 and 12 under 35 U.S.C. § 103(a)

Claims 11 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Farkash in view of Whitfield. There are several reasons why this rejection is improper, but at this time Applicant needs only to point out that the Examiner has failed to establish *prima facie* obviousness with respect to claims 11 and 12 because the Examiner has not provided a motivation or suggestion to modify Farkash or combine the teachings of Farkash and Whitfield.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.*

The Examiner acknowledges that Farkash does not teach all the elements and limitations of claims 11 and 12, and relies on Whitfield for the elements and limitations missing from Farkash. However, the Examiner fails to recite any motivation or suggestion to modify the references or to combine reference teachings, and therefore the Examiner has not established *prima facie* obviousness with respect to claims 11 and 12. Accordingly, for at least this reason, the rejection of claims 11 and 12 under 35 U.S.C. § 103(a) is improper.

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**CONCLUSION**

This Amendment is believed to be fully responsive to the Office Action mailed November 22, 2005. The remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is respectfully requested

Respectfully submitted

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